

REMARKS

Claims 23, 25, 27, 28 and 30-32 are pending in the present application, after cancellation of claims 24, 26 and 29. Claims 23, 27 and 30-32 have been amended.

Claims 23-32 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner had previously requested information to “complete the background description in the disclosure by documenting the known transmission inhibiting device as set forth in the specification (p.1, line 33 – p. 2, line 12) and Figure 2,” and documenting “the CAN transmission inhibit function (CANSTOP) of the real-time capable serial bus system (p.1, lines 10-15).” In response, Applicants noted in the Amendment dated September 29, 2004, that “the **requested information** cannot be readily obtained by Applicants at the present.” The Examiner’s rationale for rejecting the claims 23-32 as failing to comply with the written description requirement is as follows: a) since Applicants’ specification indicates that “the present invention and its underlying problem are explained with regard to a network component transmission inhibiting device of a network that is located on board a motor vehicle, namely the CAN transmission inhibit function (CANSTOP),” the Examiner contends that Applicants have “previously established **this subject matter** as the basis of the invention”; b) “Examiner has been unable to find **this information** in the specification, nor has the Examiner found any discussion of a transmission inhibit function (CANSTOP) upon detailed examination of . . . (CAN Specification, Version 2.0)”; c) Applicants indicated in the Amendment dated September 29, 2004, that “the **requested information** cannot be readily obtained by Applicants at the present”; and d) therefore, “Examiner concludes that **this subject matter as disclosed** is insufficient to enable one of ordinary skill in the art to make and use the invention as claimed.” Applicants will discuss below the deficiencies in the Examiner’s rationale.

Initially, the Examiner’s assertion that Applicants have “previously established **this subject matter** [CANSTOP function] as the *basis of the invention*” is simply incorrect. Applicants clearly indicated that “the *present invention and its underlying problem are explained with regard to* a network component transmission inhibiting device of a network that is located on board a motor vehicle, namely the CAN transmission inhibit function (CANSTOP),” which means a network component transmission inhibiting device and the CAN transmission inhibit function are presented to give *a background context* for explaining the present invention and its underlying problem, rather than *forming the basis* for the present invention.

With regards to the Examiner's contention that the Examiner has been unable to find "this information" (i.e., CANSTOP), Applicants note that original specification clearly indicated that "Fig. 2 shows such a known transmission inhibiting device for a CAN network component." (P. 1, l. 33 – p. 2, l. 1). Furthermore, with respect to the Examiner's contention that CANSTOP is not discussed in CAN Specification (version 2.0), and also with respect to the Examiner's reliance on the Applicants statement in the Amendment dated September 29, 2004, i.e., "the **requested information** cannot be readily obtained by Applicants at the present" (the Examiner requested "documentation" of CANSTOP in the 4/30/04 Office Action), Applicants note that because CAN is a data-link-layer protocol, it specifies only basic communication services, i.e., the CAN data-link-layer protocol provides only two communication services: to transmit a message and to request the transmission of a message. Users must specify an application layer and a communication profile, which defines the use of identifiers, configuration of devices, network management, and specific application objects. Therefore, Applicants submit that the lack of a "standard protocol" for CANSTOP function in the CAN Specification or the present specification cannot be the basis for the Examiner's written description rejection.

Finally, with respect to the Examiner's conclusion that "**this subject matter as disclosed is insufficient to enable** one of ordinary skill in the art to make and use the **invention as claimed**," this conclusion is not only unsupported, but also distinct from the Examiner's stated ground for the rejection, i.e., the failure to comply with the *written description requirement*. In determining compliance with the written description requirement, "the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that . . . applicant was in possession of the invention now claimed." MPEP 2163.02. Applicants note that amended independent claim 23 recites a "method for *testing an inhibit function of an inhibit device* coupled to a transmission line at a first node, the transmission line being coupled to a network component," and amended independent claim 27 recites a "device for *testing an inhibit function* of a network component transmission-inhibiting device used for inhibiting a transmission line between the network component and a network." Furthermore, in both claims 23 and 27, nothing is recited regarding the particular protocol for implementing the recited "inhibit function." The specification clearly supports the *claimed subject matter* of claims 23 and 27, i.e., a method and a device for *testing* an inhibit function. For example, Fig. 1 and the accompanying description on page 6, line 9 – page 8, line 14 fully discloses a

testing device and a corresponding method for testing a transmission inhibiting device for a CAN network component. To the extent claim 27 recites “a network component transmission inhibiting device,” this claimed feature is clearly described in the Specification, e.g., page 6, lines 35-37, and Fig. 1. Since Applicants have clearly provided ample description and support for the *claimed subject matter* in the present application, Applicants submit that pending claims 23 and 27, as well as their dependent claims, are in compliance with the requirements of 35 U.S.C. 112, first paragraph.

Claims 23-31 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,642,636 to Smith (“the Smith reference”). Claims 24, 26 and 29 have been canceled. For at least the following reasons, the Smith reference does not anticipate pending claims 23, 25, 27, 28, 30 and 31.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 730 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 23 recites, in relevant parts, “applying a logical signal to the first node from the inhibit device, wherein the logical signal is applied by closing a switch located between the first node and a supply potential, and wherein the state of the logical signal indicates whether the inhibit function is active; [and] wherein the network component is a microcontroller having an interrupt function that can be controlled via the feedback port, and wherein the inhibit function is tested by analyzing whether the interrupt function is triggered

when the inhibit function is active.” Amended claim 27 recites substantially similar features as those features of claim 23 recited above.

In support of the rejection, the Examiner contends that “Smith discloses applying a logical signal to the first node from the inhibit device (e.g., Fig. 3, ‘47’), transmitting a test signal message onto the transmission line at the transmission port (e.g., Fig. 3, ‘25’), analyzing a feedback signal at the feedback port (e.g., Fig. 5).” The Examiner further contends that “Smith also discloses testing the inhibit function by analyzing a signal with an interrupt function that can be controlled (e.g., col. 7, lines 21-22).” In addition, the Examiner further states that “Smith also discloses closing a switch between the first node and a supply potential to apply the logic signal (e.g., Fig. 3, ‘41’).” Applicants will contrast the actual teachings of the Smith reference with the claimed features in detail below.

The Smith reference deals with calibration of signal conditioning circuits on printed circuit boards, which calibration occurs “automatically at preselected intervals of time and/or when the temperature of the circuits varies a preselected amount.” (Col. 1, l. 62-67). With respect to the disclosure of col. 7, lines 19-22 of the Smith reference, this cited section merely indicates that if either of the “output signals generated by the low and high references read and stored in blocks 81 and 87” are not within preselected limits, “an alarm signal is sent to the operator’s status panel indicating the error.” With respect to the Examiner’s assertion that “Smith also discloses closing a switch between the first node and a supply potential to apply the logic signal (e.g., Fig. 3, ‘41’),” Applicants note that the description associated with element 41 of Fig. 3 indicates the following: “The decoder [41] gates this board enable signal [sent over cable 31] to the coil of the test injection relay [37] of the selected channel,” and “the test bus 45 is connected to the signal conditioning electronics 39.” (Col. 4, l. 62 – col. 5, l. 1). The Smith reference has very little to do with the claimed invention of a method and a device for **testing an inhibit function of an inhibit device**, and the Smith reference simply does not teach or suggest that “the logical signal is applied by closing a switch located between the first node and a supply potential, and wherein **the state of the logical signal indicates whether the inhibit function is active**; and wherein the **network component is a microcontroller having an interrupt function that can be controlled** via the feedback port, and wherein **the inhibit function is tested by analyzing whether the interrupt function is triggered when the inhibit function is active.**”

Since the Smith reference does not disclose each and every feature of the pending independent claims 23 and 27, the Smith reference does not anticipate independent Claims 23 and 27, or their dependent claims 25, 28, 30 and 31. It is, therefore, respectfully submitted that pending claims 23, 25, 27, 28, 30 and 31 are allowable over Smith.

Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the Smith reference in view of standard bus protocols, as evidenced by United States Patent No. 6,115,831 to Hanf ("the Hanf reference"). For at least the following reasons, the combination of the Smith and Hanf references does not render claim 32 unpatentable.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest modifying the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (citing In re Mills, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)).

Claim 32 depends from claim 27. As discussed above, the Smith reference fails to disclose each and every feature of claim 27. Furthermore, the Hanf reference does not overcome the deficiencies of the Smith reference as applied against claim 27, i.e., the Hanf reference also fails to teach or suggest that "the logical signal is applied by closing a switch located between the first node and a supply potential, and wherein the state of the logical signal indicates whether the inhibit function is active; and wherein the network component is a microcontroller having an interrupt function that can be controlled via the feedback port, and wherein the inhibit function is tested by analyzing whether the interrupt function is triggered when the inhibit function is active."

For the foregoing reasons, the Smith and Hanf references do not render obvious dependent claim 32 under 35 U.S.C. §103(a). It is, therefore, respectfully submitted that claim 32 is allowable over the combination of Smith and Hanf.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the pending claims 23, 25, 27, 28, and 30-32 are in condition for allowance. Prompt allowance of the present application is therefore earnestly solicited.

Respectfully Submitted,

KENYON & KENYON

Dated: June 21, 2005

By: _____

for Richard L. Mayer (64
Richard L. Mayer
Reg. No. Reg. No. 22,490
(212) 425-7200
CUSTOMER NO. 26646

John
n. no.
36,197)